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DATE: AUGUST 14, 2001

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FROM: SALIM A. HASAN

DIRECT LINE: 312-616-5607

REGISTRATION No. 38,175

TO: EXAMINER CHRISTOPHER L. CHIN  
GROUP 1641UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C.

TELEPHONE NUMBER: 703-308-3991

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**FAX RECEIVED**  
AUG 15 2001  
GROUP 1600

IN RE APPLN. OF: NIE ET AL.  
APPLICATION No. 09/405,653  
FILED: SEPTEMBER 24, 1999  
FOR: WATER-SOLUBLE LUMINESCENT QUANTUM DOTS AND  
BIOMOLECULAR CONJUGATES THEREOF AND RELATED  
COMPOSITIONS AND METHODS OF USE THEREOF  
GROUP ART UNIT: 1641  
EXAMINER: C. CHIN

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☒ Be sent via U.S. Mail.

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#16  
8/22/01

PATENT  
Attorney Docket No. 202406

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application Of:

Nie et al.

Serial No. 09/405,653

Group Art Unit: 1641

Examiner: C. Chin

Filed: September 24, 1999

For: WATER-SOLUBLE LUMINESCENT QUANTUM DOTS  
AND BIOMOLECULAR CONJUGATES THEREOF  
AND RELATED COMPOSITIONS AND METHODS  
OF USE THEREOF

FAX RECEIVED

AUG 15 2001

GROUP 1600

RESPONSE TO OFFICE ACTION

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

In response to the Office Action dated July 31, 2001, applicants enclose herewith a copy of the "Response to Restriction Requirement" previously submitted on May 10, 2001, in connection with the above-identified patent application. Also enclosed is a copy of the postcard submitted by applicants with the "Response to Restriction Requirement." Notably, the postcard has been stamped by the U.S. Patent and Trademark Office, thereby evidencing applicants' proper submission of all 4 pages of the "Response to Restriction Requirement" at that time.

This document is being submitted by facsimile, with a confirmation copy via First Class mail, to expedite prosecution of the application. The application is believed to be in condition for allowance and, thus, passage of the application to issuance is courteously solicited.

In re Appln. of Nie et al.  
Serial No. 09/405,653

Respectfully submitted,



Salim A. Hasan, Registration No. 38,175

One of the Attorneys for Applicant(s)

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180 North Stetson

Chicago, Illinois 60601-6780

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(312) 616-5700 (facsimile)

Date: August 14, 2001

In re Appln. of Nie et al.  
Serial No. 09/405,653

CERTIFICATE OF FACSIMILE TRANSMISSION

The undersigned hereby certifies that the following documents:

1. Response to Office Action (2 pages);
2. Copy of Response to Restriction Requirement (4 pages);
3. Certificate of Facsimile Transmission (1 page);
4. Facsimile Cover Sheet (1 page); and
5. Copy of Post Card that Accompanied Response to Restriction Requirement (1 page),

are being transmitted by facsimile and U.S. mail to the United States Patent and Trademark Office, Attention: Examiner Christopher L. Chin, Group 1641, Facsimile Number (703) 308-4242 on the date indicated.

Date: August 14, 2001 Debra L. Hall

In re Application of: Nie et al.

Serial No. 09/405,653

Filed: September 24, 1999

For: WATER-SOLUBLE LUMINESCENT QUANTUM DOTS AND BIOMOLECULAR CONJUGATES  
THEREOF AND RELATED COMPOSITIONS AND METHODS OF USE THEREOFASSISTANT COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

Sir:

Transmitted herewith is a response to an office action in the subject application.

- ☒ Small entity status of this application under 37 C.F.R. §§ 1.9 and 1.27 has been established by a verified statement previously submitted.
- ☐ A verified statement to establish small entity status under 37 C.F.R. §§ 1.9 and 1.27 is enclosed.
- ☐ Petition For Extension Of Time
- ☐ Applicant(s) petitions for a one-month extension of time under 37 C.F.R. § 1.136, the fee for which is \$110.00 (enclosed).
- ☒ Applicant(s) believes that no petition for an extension of time is necessary. However, to the extent that such petition is deemed necessary, applicant(s) hereby petition for a sufficient extension of time to render the present submission timely. Please charge Deposit Account No. 12-1216 for the appropriate petition fee.
- ☒ No additional claim fee is required.
- ☒ Other: Response to Restriction Requirement

The claim fee has been calculated as shown below:

					SMALL ENTITY		OTHER THAN A SMALL ENTITY			
		CLAIMS REMAINING AFTER AMENDMENT			HIGHEST NUMBER PREVIOUSLY PAID FOR	EXTRA CLAIMS PRESENT		ADDIT. CLAIM FEE		ADDIT. CLAIM FEE
							RATE		RATE	
TOTAL		25	MINUS	68	=0		x 9=	\$0.00	x 18=	\$0.00
INDEPENDENT		3	MINUS	3	=0		x 39=	\$0.00	x 78=	\$0.00
<input type="checkbox"/>	FIRST PRESENTATION OF MULTIPLE CLAIM						+ 130=	\$0.00	+ 260=	\$0.00
							TOTAL	\$0.00	TOTAL	\$0.00

- ☐ Please charge my Deposit Account No. 12-1216 in the amount of \$0.00. A duplicate copy of this sheet is attached.
- ☐ A check in the amount of \$0.00 is attached.
- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 12-1216. A duplicate copy of this sheet is attached.
- ☒ Any filing fees under 37 C.F.R. § 1.16 for the presentation of extra claims.
- ☒ Any patent application processing fees under 37 C.F.R. § 1.17.

Respectfully submitted,

LEYDIG, VOIT &amp; MAYER, LTD.

By

Salim A. Hasan, Reg. No. 38,175  
One of the Attorneys for Applicant(s)

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AMDTRM (Rev. 11/12/1998)

**PATENT**  
Attorney Docket No. 202406

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Nie et al.

Group Art Unit: 1641

Application No. 09/405,653

Examiner: K. Pham, Ph.D.

Filed: September 24, 1999

For: WATER-SOLUBLE LUMINESCENT  
QUANTUM DOTS AND  
BIOMOLECULAR CONJUGATES  
THEREOF AND RELATED  
COMPOSITIONS AND METHODS  
OF USE THEREOF

**RESPONSE TO RESTRICTION REQUIREMENT**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

In response to the Office Action dated April 24, 2001, please consider the following remarks.

**REMARKS**

Summary of the Restriction Requirement

The Office sets forth a restriction requirement between Group I (claims 1-23), which is directed to a water soluble luminescent quantum dot, and classified in Class 257, subclass 40; and Group II (claims 38-39), drawn to a method of making a water soluble luminescent quantum dot, and classified in class 438, subclass 758.

Election with Traverse

Applicants hereby elect, with traverse, the claims of Group I for examination. In this regard, Applicants respectfully submit that the claims of Group II should be examined with the claims of Group I for the reasons set forth below.

In re Nie et al.  
Application No. 09/405,653

Discussion of Restriction Requirement

The Office clearly fails to satisfy the requirements for a proper restriction requirement. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the examiner if restriction is not required. M.P.E.P. § 803. Consequently, as set forth in M.P.E.P. § 803, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, *even though it includes claims to distinct or independent inventions*" (emphasis added). As such, both of these criteria must be met for a restriction requirement to be proper. The Office has failed to establish that examination of all of the claims would constitute a serious burden on the examiner if restriction were not required. In this respect, both a search and examination of all of the claims of Groups I and II have been conducted already. Indeed, the Office Action dated September 19, 2000, entailed a substantive examination and search of claims 1-23 and 38-39 (i.e., all of the claims of Groups I and II). Accordingly, there would be no "serious burden" on the Examiner to search and examine the claims of Groups I and II together, as evidenced by the fact that such search and first examination have been done already.

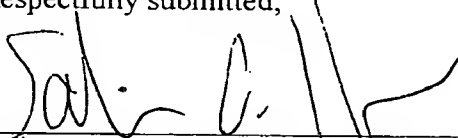
Therefore, in the instant case, the restriction requirement is not proper. As such, Applicant respectfully requests the withdrawal of the restriction requirement and consideration of the claims of Group II, in addition to those of elected Group I.

In re Nie et al.  
Application No. 09/405,653

Conclusion

The application is considered to be in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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Salim A. Hasan, Reg. No. 38,175  
One of the Attorneys for Applicants  
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Chicago, Illinois 60601-6780  
(312) 616-5600 (telephone)  
(312) 616-5700 (facsimile)

May 8, 2001



In re Nie et al.  
Application No. 09/405,653

CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO RESTRICTION REQUIREMENT (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

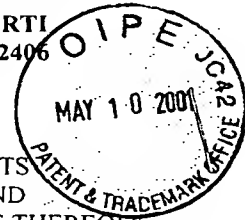
Date: May 8, 2001

Debbie Hall

THE PATENT AND TRADEMARK OFFICE IS RESPECTFULLY REQUESTED TO PLACE ITS STAMP ON THIS POSTAL CARD AND PLACE IT IN THE OUTGOING MAIL TO SHOW THE FOLLOWING PAPERS HAVE BEEN RECEIVED.

MAILED: May 8, 2001  
SAH/dlh

ARTI  
Attorney Docket: 202406



**RESPONSE TO RESTRICTION REQUIREMENT**

Application No. 09/405,653 filed September 24, 1999

"WATER-SOLUBLE LUMINESCENT QUANTUM DOTS  
AND BIOMOLECULAR CONJUGATES THEREOF AND  
RELATED COMPOSITIONS AND METHODS OF USE THEREOF"

Applicant: Nie et al.

**DNG**

Enclosed:

- Response to Restriction Requirement (4 pages)
- Transmittal Sheet (1 page in duplicate)
- Return Postcard

**LH**